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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/743,330	01/05/2001	Daniel Eugene George	AD-6580	9328

23906 7590 11/05/2002

E I DU PONT DE NEMOURS AND COMPANY
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WILMINGTON, DE 19805

EXAMINER

FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

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DATE MAILED: 11/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/743,330

Applicant(s)

GEORGE ET AL.

Examiner

Lawrence D Ferguson

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed August 14, 2002.
- Claims 1-3 were amended and claim 4 was added rendering claims 1-4 pending.

Abstract

- w/d
2. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required. There is no indication of an Abstract in this Application.

Claim Rejections – 35 USC § 103(a)

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 04102883 in view of Satoji (U.S. 4,687,696).
5. JP '883 discloses a separating pawl of a copying machine prepared by adding polytetrafluoroethylene resin with polyimide resin at 40 to 90wt% and the 60 to 10wt% of fluororesin where the material is compression molded and sintered (abstract). A separating pawl

is analogous to a separation finger and a copying machine is an Electro photographic device. Furthermore, a separation finger for Electro photographic devices is considered to be intended use, which is given little patentable weight. Applicant teaches separation figures having configurations of 70um or less in finger tips diameter are known in the art. JP '883 does not disclose the weight average molecular weight.

Satoji teaches finger strips for copying machines having polyimide resins mixed with polytetrafluoroethylene resin (column 1, lines 4-5 and 35-40) where the fluorinated resin has an average molecular weight of 1000 to 5000 (column 7, lines 1-11) and average particle sizes, which are conventional to the art. Satoji teaches contact angles for repelling water being at least 90°C in table 1. Although Satoji does not disclose the exact range of weight average molecular weight as the claimed invention, it would have been obvious to one of ordinary skill in the art to include the amount as claimed, because the referenced art includes the same material with the same function as Applicant's claimed invention. JP '883 and Satoji are analogous art because they are from the same field of separation fingers. It would have been obvious to one of ordinary skill in the art to include the average molecular weight and contact angles in the separation finger of JP '883 because Satoji teaches that average molecular weight helps to reduce jamming of a copying machine and the contact angle helps reduce adhesion of the papers in the copier.

Response to Arguments

6. Objections made to the specification are withdrawn due to Applicants amending of the specification. However, objections made to the abstract are maintained because there is no indication of an Abstract in this Application. Additionally, objections made to claims 1-3 for the lines being crowded too closely together are withdrawn due to Applicants amending of the claims.

Applicant's remarks to the rejection made under 35 USC 112, second paragraph have been considered and the rejections are withdrawn due to Applicant's amending of claims 1-3.

Applicant's remarks to the rejection made under 35 USC 103(a) as being unpatentable over JP 04102883 in view of Satoji (U.S. 4,687,696), have been considered but are unpersuasive. Applicant argues that no suggestion or motivation can be found in the cited references for combining the prior art as suggested by Examiner. This is not true because, as indicated in the previous rejection, JP '883 and Satoji are analogous art because they are from the same field of separation fingers. Applicant argues Satoji does not disclose or suggest a finger strip for copying machines being formed of a blend of polyimide and polytetrafluoroethylene resin powder with compression-molding and sintering processes. This limitation is directed to a product by process claim limitation. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966.

Applicant further argues the present invention has its tip diameters being fifty micrometers or less because of no fluorinated polyether polymer coating. There is nowhere in the claims that discloses "no fluorinated polyether polymer coating." Applicant argues JP '883 lacks a disclosure of the weight average molecular weight. Although neither reference discloses the exact range of weight average molecular weight as the claimed invention, it would have been obvious to one of ordinary skill in the art to include the amount as claimed, because the JP '883 n view of Satoji includes the same material with the same function as Applicant's claimed invention. Additionally, Applicant has to show evidence teaching why the cited art can not obtain the same properties as instantly claimed and why the instant application is an improvement over the cited references. Applicant points to Tables 1-3 to show how the instant application is an improvement over conventional properties; however, these Tables are not directed to either JP '883 or Satoji and therefore do not overcome the rejections.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson
Examiner
Art Unit 1774

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

